

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO./ CUSTOMER NO.
10/714,765	17 November 2003	Salvatore J. Puleo Sr.	NATREE 3.1-004US 39428
			EXAMINER Jason Han
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REMARKS

Claims 12-27 are pending in this application, all of which were rejected by the Examiner in the Official Action mailed October 20, 2004. Claims 14 and 19 have been amended to more accurately reflect the nature of the invention.

The Examiner states in paragraph 1 of that Official Action that the present application may be entitled to claim the benefit of a previously-filed U.S. Patent application under 35 U.S.C. 120 and 37 C.F.R. 1.78. In a telephone conversation with the Examiner on April 19 2005, the Applicant confirmed that such a priority filing date has been granted in this application as provided-for in the Filing Receipt mailed May 25, 2004.

Each of the claims in this application was rejected under 35 U.S.C. 103(a) in view of various combinations of five different references; different claims being rejected in view of different references. These rejections are addressed group-wise below based on the claims rejected and the references cited.

Applicant respectfully asserts that in each of the rejections provided by the Examiner, none of the cited references, either alone or in combination, establish a *prima facie* case of obviousness. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." See MPEP 2143.

The Examiner has rejected claims 12 and 13 under 35 U.S.C. 103(a) as being unpatentable over Pietrantonio et al. (U.S. Pat. No. 4,858,086) in view of Kacheria (U.S. Pat. No. 5,779,353). With regard to claim 12, the Examiner has properly stated that Pietrantonio does not teach the shell/stand further incorporating an additional support or a cover disposed atop the shell as a means for ventilation.

The Applicant respectfully asserts that the Examiner is incorrect in the statement that "it would have been obvious to modify the shell/stand of Pietrantonio to incorporate the weather-protecting the method of Kacheria in order to provide appropriate heat dissipation for the

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AMENDMENTS TO THE DRAWINGS

The Examiner has objected to the drawings by noting several minor errors in the element numbering and reference designations. The Examiner is respectfully requested to accept Replacement Sheets 2/10, 3/10 and 5/10 to correct the cited errors. COPIES of these sheets, as well as duplicate copies of the other drawing sheets, are attached to this Response. Official copies of these Figures were mailed to the Official Draftsperson on April 19, 2005, a copy of that correspondence is also attached to this Response. Other cited errors are corrected within the Specification as provided in the Amendments to the Specification below. No new matter has been introduced in making these Amendments.

The drawing corrections are summarized as follows:

OA Para 2: Original reference number 38 has been removed from Fig. 2C and applied to Fig. 2B as renumbered element 42. Element 42 now designates the proper diameter. Certain other solid and hidden lines in Figs. 2B and 2C have also been changed to accurately reflect the construction of the top and bottom of the base. Appropriate changes to the specification have been made as provided below.

OA Para 3: The correction for OA Para. 2 above obviates this objection.

OA Para. 4: Reference element 213 on Fig. 5A has been removed as unnecessary.

OA Para. 5: Electrical access opening or port 342 of Fig. 5A has been renumbered element 344. Appropriate changes to the specification have been made as provided below.

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shell/stand in addition the protection of the weather extremes, and thus further offering safe operation.” OA para. 8. As a first matter, overheating is not mentioned as a problem to be addressed anywhere in Pietrantonio. In fact, Pietrantonio suggests using low voltage light sources and current adapters to avoid this problem, thus teaching away from the need for solving an overheating problem. Col. 5, ll. 60-65. Second, the only mention in that reference regarding protection from adverse weather conditions is provided in connection with generalized decorative bases shown in Figs. 8-10 therein. Col. 6, ll. 22-34. These bases are presumably used with different types of lighted displays (i.e. not trees) and there is no suggestion or motivation within the Pietrantonio et al. reference to modify or combine its teachings with any reference, including Kacheria, so as to provide the weather protection that Kacheria does. In particular and unlike the tree stand 18 provided in Fig. 2 of Pietrantonio et al., the generalized bases of Figs. 8-10 are not necessarily disposed in a generally vertical orientation such that they require support for maintaining that orientation when the lighted decoration is inserted into it. Since these generalized bases have no disclosed specific orientation, there is no need to provide a cover having a hole on a downward facing surface to provide weather-proofing. In fact, Pietrantonio et al. discloses only a general sliding plastic cover 165 as the preferred method of protecting against adverse weather conditions, and that cover is used to protect the lighted display, not the base.

Further, even if one of skill in the art was provided incentive to combine these references, the combined invention would not function in the same manner as the Applicant's claimed invention. In this regard, the combined invention would not contain all the limitations of the claimed invention. Specifically, Pietrantonio's sliding plastic cover, even if perforated to provide Kacheria's ventilation holes: 1) would not necessarily have its own inner volume in contact with the inner volume of the shell; 2) would not necessarily have an extension extending beyond the lateral surface of the shell and 3) would not have a receptacle to contain a fiber optic decoration. In fact the weather proofing slide cover 165 of Pietrantonio is not even associated with the heat generating, environmentally susceptible shell of the base 160, but rather it provides environmental protection for the fiber optic decorations themselves and thus can not have a receptacle for the decorations (i.e. itself).

With regard to claim 13, the Applicant respectfully asserts that door 75 in Pietrantonio is provided on the decorative display itself, not the shell (base), and further, the door is provided for the purpose of replacing the light sources not the electrical components within the shell.

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Even if Pietrantonio's base was modified to include the door for that purpose, the combined invention would not contain all the limitations of the claim 13 for the reasons mentioned with respect to claim 12 above.

The Examiner has provided numerous combinations of third references with Pietrantonio et al. and Kacheria in rejecting claims 14 -18 under 35 U.S.C. 103(a) as provided in paragraphs 10-12 of the Official Action. Claims 14-18 are either directly dependant or derivatively dependant on Claim 13. For the reasons mentioned above with respect to the claims 12 and 13, the Applicant respectfully asserts that the combination of Pietrantonio et al. and Kacheria is both unmotivated and does not contain all the limitations of Claims 12-13. Thus the Applicant repeats those assertions with respect to the Examiner's rejections provide in paragraphs 10-12 and offers additional remarks with respect to the third references used in those rejections.

In each of the three groups of rejections within paragraphs 10-12 of the Official Action, the Examiner correctly states that the combination of Pietrantonio et al. and Kacheria does not "teach the access door/panel from being opened with the electrical power is applied to the electrical components of the device." This is entirely correct and forms the *raison-de-etre* for the protection mechanisms of claims 14-18. As mentioned above, door 75 in Pietrantonio is provided on the decorative display itself, not the shell (base), and is provided for the purpose of bulb replacement. In fact, it may be advantageous for this purpose to leave the power supplied to the display while replacing the bulb so as to verify the proper operation of the lights without repeatedly opening and closing the door. Not only is there no motivation within either Pietrantonio et al. and Kacheria to combine further inventions to provide electrical safety when opening Pietrantonio's door (Kacheria has no door), the combination of the references actually teaches away from including a safety mechanism. Thus there is no motivation to combine further references to provide the safety mechanisms of claims 14-18.

Further, the Applicant respectfully asserts that the third references provided in each of the rejections within paragraphs 10-12 are not analogous in that they would not have logically commanded themselves to the Applicant's attention when trying to solve the safety problems of the present invention. In particular, none of the three references, Marzec (U.S. Pat. No. 3,660,798) (directed to mechanical interlocking devices), Scalza et al. (U.S. Pat. No. 3,910,617) (directed to solenoids) and Thorne (U.S. Pat. No. 2,298,518) (directed to electrical interlocks) are in any way related to commercial decorative displays or safety devices within them. The

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fact that the reference can be combined or modified does not render the resulting combination obvious without a suggestion as to the desirability of the combination. *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990). As discussed above, there is no demonstrated desirability to provide the elements of claims 14-18 to the teachings of Pietrantonio et al. and Kacheria, which in and of themselves, do not properly render obvious claims 12-13 upon which claims 14-18 are based.

The Examiner has rejected claim 19 under 35 U.S.C. 103(a) as being unpatentable solely over Pietrantonio et al. With regard to claim 19, the Examiner has properly stated that "Pietrantonio does not teach the [embodiment of claim 19] having a door." With respect to claim 20, the Examiner has rejected claim 20 under 35 U.S.C. 103(a) as being unpatentable over Pietrantonio et al. in view Kacheria and further in view of any one of Marzec, Scalza et al. or Thorne.

Applicant has amended claim 19 to incorporate the limitations of claim 20. As discussed above with respect to claim 13, and 14-18, door 75 in Pietrantonio is provided on the decorative display itself, not the shell (base), and is provided for the purpose of bulb replacement. In fact, for this purpose itself, it may be advantageous in Pietrantonio to leave the power supplied to the display while replacing the bulb so as to verify the proper operation of the lights without repeatedly opening and closing the door. Not only is there no motivation within Pietrantonio et al. to combine further inventions to provide electrical safety when opening Pietrantonio's door, the Pietrantonio actually teaches away from including a safety mechanism. Further, Pietrantonio suggests using relatively safe low voltage light sources and current adapters, thereby obviating the need for solving any safety problem. Thus there is no motivation to combine further references with Pietrantonio to provide the safety mechanisms of amended claim 20.

The Examiner has provided numerous combinations of three references with Pietrantonio et al. in rejecting claims 20-24 under 35 U.S.C. 103(a) as provided in paragraphs 14-16 of the Official Action. As provided above, Applicant alleges that dependant claim 20 (now amended independent claim 19) is allowable. Claims 21-24 are all dependant on Claim 19. (The Examiner should note that the dependencies for these claims were originally improper – but are now proper – since they all should have been dependant on claim 20 not claim 19.)

In each of the three groups of rejections within paragraphs 14-16 of the Official Action, including those directed to amended claim 19, the Examiner correctly states that the

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combination of Pietrantonio et al. and Kacheria does not “teach the access door/panel from being opened with the electrical power is applied to the electrical components of the device.” This is entirely correct and forms the *raison-de-etre* for the protection mechanisms of claims 21-24. As mentioned above, door 75 in Pietrantonio is provided on the decorative display itself, not the shell (base), and is provided for the purpose of bulb replacement. In fact, it may be advantageous for this purpose to leave the power supplied to the display while replacing the bulb so as to verify the proper operation of the lights without having to repeatedly open and close the door. Not only is there no motivation within either Pietrantonio et al. and Kacheria to combine further inventions to provide electrical safety when opening Pietrantonio’s door (Kacheria has no door), the combination of the references actually teaches away from including a safety mechanism.

As previously discussed, the Applicant respectfully asserts that the third references provided in each of the rejections within paragraphs 14-16 are not analogous in that they would not have logically commanded themselves to the Applicant’s attention when trying to solve the safety problems of the present invention. In particular, none of the three references, Marzec are in any way related to commercial decorative displays or safety devices within them. The fact that the reference can be combined or modified does not render the resulting combination obvious without a suggestion as to the desirability of the combination. *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990). As discussed above, there is no demonstrated desirability to provide the elements of claims 21-24 to the teachings of Pietrantonio et al. and Kacheria, which in and of themselves, do not properly render obvious claim 19 upon which claims 21-24 are based.

The Examiner has rejected claims 25-26 under 35 U.S.C. 103(a) as being unpatentable over Pietrantonio et al. in view of Scalza. With all due respect, the Applicant asserts that Pietrantonio et al., alone or in combination with Scalza, does not disclose a separate and distinct holder (as the Applicant has defined it – see Prelim. Amend., p. 8, ¶1) on which electrical components are mounted within a decorative lighting system. The Examiner’s attention is also directed to element 300 of Fig. 6B as one example of a particularly preferred embodiment of such a holder (a slidable tray). Contrary to the Examiner’s statements, element 18 of Pietrantonio et al. is the stand itself and not an independent holder for mounting the electrical components within the system. None of the other references cited by the Examiner in paragraphs 17-18 of the Official Action provide this element as claimed and defined by the applicant.

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Thus the Applicant asserts that all the claims in the application are now in condition for allowance, and the Applicant respectfully requests issuance of the application.

Finally, two IDS' are being submitted concurrently with this Response. It is respectfully requested that the Examiner conduct the remaining examination in view of the submitted references and return an initialed copies of the IDS forms indicating such.

The Examiner is encouraged to contact the representative for the Applicant with any questions concerning this application.

Respectfully submitted,



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